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In The

Supreme Court of the United States

OCTOBER TERM, A. D. 1950

No. 214

FRUEHAUF TRAILER COMPANY, a Corporation,
Petitioner,
vs.
HENRY CLAY MYERS,
Respondent

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

ARTHUR W. DICKEY,
Counsel for Petitioner.

HARNESS, DICKEY & PIERCE,
7—141 General Motors Building,
Detroit 2, Michigan;

PENDERGRASS, SPACKMAN & BULLIVANT,
527 Pacific Building,
Portland 4, Oregan;

DAVIES, RICHBERG, BEEBE, LANDA & RICHARDSON,
1000 Vermont Avenue, N.W.,
Washington 5, D. C.,
Of Counsel.

Interstate Brief & Record Co., 642 Beaubien St., Detroit, Michigan

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Myers v. Fruehauf Trailer Company of California, 79 U. S. P. Q. 173, District Court of Oregon. No report appears in Federal Reporter System. Court of Appeals, Ninth Circuit, Opinion on Appeal from Decision reported above was per curiam and appears in transcript of record, Vol. IV, p. 1416.

The following reported opinions are in earlier suits for infringement of the same patent. Petitioner was not a party to these cases. These opinions take no consideration of the applicable law presented in the case at bar:

Myers v. Beall Pipe & Tank Corp., 36 F. Supp, 752, District Court of Oregon. No appeal taken.

Page et al. v. Myers, 155 F. (2) 57, Circuit Court of Appeals, Ninth Circuit, on Appeal from unreported decision of District Court of Oregon.

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No.....

FRUEHAUF TRAILER COMPANY OF CALIFORNIA,
doing business in Oregon as Fruehauf Trailer
& Equipment Company,
Petitioner,
vs.
HENRY CLAY MYERS,
Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

To the Honorable Frederick M. Vinson, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your Petitioner respectfully shows:

SUMMARY STATEMENT OF MATTER INVOLVED

Petitioner seeks review of a Judgment of the United States Court of Appeals for the Ninth Circuit entered on

March 24, 1950, and an Order of the same Court entered on May 10, 1950, denying Petitioner's Petition for Rehearing filed on April 22, 1950 (Tr. Vol. IV, pp. 1417-1418).

1. This Judgment affirmed, per curiam, a Judgment of the United States District Court for the District of Oregon entered on April 13, 1949 (Tr. Vol. I, pp. 68-69), adjudging United States Letters Patent No. 2,090,874, dated August 24, 1937, for a Trailer, to be valid and infringed by Petitioner.

2. The patent in suit (Tr. Vol. III, pp. 1095-1098) describes and claims a specific construction of dual axle trailer for hauling logs. No variant or alternate construction is suggested, disclosed or claimed in the patent.

There is no dispute about the facts respecting the patent and trailer construction it describes and claims, or about the facts respecting the construction of Petitioner's trailers which have been held to infringe the patent, or about the fact that the patent fails to show, describe or claim Petitioner's structures.

The Courts below have found infringement by applying the doctrine of equivalents in the face of uncontroverted evidence which under the decisions of this Court precludes the application of that doctrine to find Petitioner's trailer structures an infringement of the patent.

Consequently, the rule that the Supreme Court will accept concurrent findings of the lower courts on questions of fact has no application in this case as it is a patent infringement suit in which the question of infringement depends upon a comparison between the structures disclosed on the face of the patent and the alleged infringing device, and the correct application thereto of the rule of equivalency in view of uncontroverted evidence precluding, as a matter of law under the applicable decisions of this

Court, the application of the doctrine. *Sanitary Refrigerator Co. v. Winters,* 280 U. S. 30, 36; 74 L. Ed. 147, 153.

3. The Courts below have so enlarged the scope of the patent by construing it as to constitute it a radically different patent than that granted by the Patent Office and accepted by the patentee, and one having a scope and breadth of monopoly of which business, industry and the public could never learn or be informed or warned by examining the patent, and by so doing have made it an instrument which is misleading to the public.

4. The patent in suit (Tr. Vol. III, pp. 1095-1098) has four claims, each of which explicitly calls for a definite element of construction *which is not present* in Petitioner's constructions held to infringe. That element, clearly shown in Figures 1 and 3 of the patent and described in column 1, lines 53-55, column 2, lines 1-3, is the outer side of the forked frame member 15 extending or projecting above the cross member 10 to form rub plates 16. This element is specifically called for in the claims of which Claim 1 is typical, as indicated by italics:

Claim 1

> "In a trailer the combination of a cross member adapted to be connected to reach, a downturned extending forked frame at each end of said cross member, *the outer side of each frame extending above the top of said cross member to form rub plates,* and wheel uniting springs rotatably mounted between the forked ends of said frame."

5. In his application as originally filed (Tr. Vol. III, pp. 1117, 1125-1130) the patentee sought a broad claim which did *not* call for the element in question—the outer side of the fork extending above the top of the cross member to form rub plates. This was the first claim of his ap-

plication and it was rejected by the Patent Office in view of prior art. Applicant agreed with the rejection and abandoned the claim. All other claims presented are those that are now in the issued patent, and contain the element in question, and that element was emphasized and relied upon by the applicant to obtain allowance of the patent.

6. Respondent now seeks (Tr. Vol. II, pp. 767-771) to have the patent construed as though it described and claimed his different and prior trailer structure which did not employ the element in question and which Respondent deliberately refrained from disclosing or suggesting in his patent.

Respondent had in 1935 (Tr. Vol. II, pp. 767-768), prior to the invention in 1937 (Tr. Vol. II, pp. 913-914) of the trailer construction shown in his patent, a different trailer construction which *did not* contain the element in question, i.e., the outer side of the forked frame member extending above the cross member to form rub plates (Tr. Vol. II, pp. 753, Ex. R-11). He knowingly refrained from including or suggesting this prior 1935 construction in his application for patent (Tr. Vol. II, pp. 918-923, 972-973). His prior construction is shown in Exhibit R-11 (Tr. Vol. III, p. 1101), which is reproduced in the appendix hereto. This drawing clearly shows that the outer side 1 of the forked frame member (designated as "Removable Side Bracket Outside Support") does not extend above the cross member 7 and horizontal frame member 6, and does not form rub plates. The rub plates 3 are separate parts mounted upon the top of the frame members 6 and 7 and constitute no part of the outer side 1 of the forked frame member. No disclosure or suggestion of this trailer construction appears in the patent.

7. None of Petitioner's structures have the element explicitly called for by the claims of the patent, i.e., the outer sides of the forked frame member extending or projecting above the cross member to form rub plates. Petitioner's trailer structures held to infringe are shown in the drawings contained in the appendix hereto.

(Note: These drawings are reproduced from photographs, Exhibits 117, 118, 119, 120, 121, 122, 122-A, 122-B-13 and 122-B-14 printed in Tr. Vol. III, pp. 1323-1339, and from blueprints not printed due to size, which are Exhibits 122-B-5 to 122-B-9, 122-B-10, 122-B-11 and 122-B-12.)

There is no dispute about these constructions. They are fully explained and described in the testimony of the witness Bistrom who designed them (Tr. Vol. II, 575-619).

As shown in the appendix drawings, Petitioner has six differing constructions which have been held to infringe. In the drawings, the lower figures show the separate parts of Petitioner's trailers before they are assembled and secured together. The names of the parts are applied thereto. The central figures in each drawing show typical cross sections of the cross members of Petitioner's trailers, and the upper figures show the parts assembled and secured together. In all of Petitioner's structures the forked frame members, including the outer sides thereof, terminate at the under side of the cross member and do not extend above it, and do not provide or form rub plates. In Petitioner's first construction the forked frames are single parts welded to the under side of the cross member. In the second and third constructions the forked members consist of two parts—the inner leg and head which are welded to the under side of the cross member, and the outer leg which is a separate part bolted to the head portion of the inner leg. In the second and third constructions, the outer leg or side of the forked member does not engage and is not secured to the cross member. In the fourth,

fifth and sixth constructions the inner and outer legs of the forked member are separate parts each of which is welded to the under side of the cross member.

In each of Petitioner's constructions the rub plates are separate parts which are placed upon and welded to the top side of the cross member and which are entirely supported by the cross member. They form no part of and have no engagement with the outer sides of the forked frame members. In none of Petitioner's constructions are the rub plates located directly above the outer sides of the forked frame members. In the first construction the inner edge of the rub plate on the cross member is spaced 2-7/16" beyond a point located directly above the outer side of the forked frame member; in the second and third constructions it is located 3-½" beyond; in the fourth and fifth constructions it is located 6-½" beyond; and in the sixth construction it is located 7-¼" beyond.

8. Petitioner's trailers do not employ the function of the claim element in question. The function and principle of this element—the outer side of the forked member extending or projecting above the cross member to form rub plates—is stated by Respondent in his testimony (Tr. Vol. II, p. 765), where he said that what he did that was different from what had been done before was to:

> "* * * put a rub plate out over the outside leg of the straddle mounting, so that the weight fell through the leg and went to the trunnion shaft and relieved some of the weight that would fall on your cross member."

And (Tr. Vol. II, p. 876), where he stated:

> "The principle of it was that you get your rub plate out far enough that when tremendous shock would hit your trailer from one side to the other and over rough road, it would absorb the weight and

carry it down directly instead of through your cross beams. That was the principle of the operation."

It is clear from this testimony that the function and principle of the upwardly projecting outer side 15 of the forked frame member of the patent extending above the cross member 10 to form rub plates 16 was to directly engage the swinging bunk 13 independently of the cross member 10 and to transmit weight directly through the upwardly projecting outer side of the forked member 15 to the trunnion pins 24 and thereby to relieve some of the weight that would otherwise be imposed upon the cross member 10 as the swinging bunk 13 carrying the logs rocked from side to side due to unevenness of the road.

It is obvious that Petitioner's trailer structures lack both the element in question (i.e., the outer side of the forked member extending above the cross member to form rub plates) and its function, as in Petitioner's structures the rub plates are carried by the cross member itself; they form no part of the outer side of the forked frame member, for that member terminates at the under side of the cross member. All load on the swinging bunk in Petitioner's trailers is imposed upon the cross member, as the rub plates are mounted upon and carried by the cross member. There is nothing in Petitioner's structures by means of which the weight on the swinging bunk can fall directly through the outer leg or side of the forked member to the trunnion shaft and relieve weight that would fall on the cross member, nor any part that will absorb any part of the weight of the bunk and carry it down or transmit it directly to the trunnion pins instead of through the cross beams or cross members.

9. Petitioner's structures are but the obvious aggregation of elements of construction conceded to be old and

known in the prior art, none of which function or operate any differently than they did in the art prior to the patent, and as such are not subject under the law to the monopoly of the patent.

Bistrom, Witness for Petitioner, testified (Tr. Vol. II, p. 629) that there was no difference in function between the swinging bunks and main frame members in Petitioner's constructions and the construction shown in the prior expired patent to Merrill 1,570,165, dated January 19, 1926, relating to Logging Trailers (Defendant's Exhibit R-20; Tr. Vol. III, pp. 1157-1167). Respondent Myers confirmed this in his testimony (Tr. Vol. II, pp. 951-954), which confirmation the District Court completely ignored and disregarded.

The use of forked frame member or straddle type mountings to transmit the load from cross members and load carrying frames of dual axle trailers to the trunnions secured to the springs is conceded to be old in the prior art, and was so recognized by the District Court (Tr. Vol. II, pp. 557-558). The witness Bistrom testified (Tr. Vol. II, pp. 618-619) that there is no difference in function or operation in transmitting the load imposed upon the frames between the logging trailers such as Petitioner's logging trailers and the conventional freight trailers of the prior art which use the forked frame members. This is not denied by Respondent, who produced no evidence to show that the forked frame members of Petitioner's constructions are any different or operate any differently than those of the prior art.

Bistrom testified that the purpose of the rub plates in Petitioner's constructions is to facilitate steering and to prevent the swinging bunk from wearing into the cross member, and that the rub plates could as well be made

flush with the top of the cross member except that it would be more costly to construct than it was to place a piece of steel on the top of the cross member for a rub plate (Tr. Vol. II, 634, 635). Respondent produced no evidence to controvert this testimony. Respondent concedes (Tr. Vol. II, pp. 885-887 and 924-925) that it was common prior to any invention that he claims to put rub plates on the frames that supported the swinging bunks and to locate them a substantial distance outwardly from the kingpin upon which the bunk pivoted, and (Tr. Vol. II, pp. 924-925) that logging trailers with swinging bunks and wear plates were used to facilitate steering prior to any invention of his.

10. The District Court, and the Court of Appeals which affirmed, have cast aside and ignored the explicit and unambiguous claims of the patent which do not describe or claim Petitioner's structures held to infringe, and have treated the patent as though it were for a combination of elements nowhere claimed therein, and have enlarged and made of it a patent which was neither claimed nor granted.

The District Court in its Finding of Fact X (Tr. Vol. I, p. 60) finds an invention in the patent which the patent itself conclusively demonstrates was neither claimed nor granted:

> "Invention is present in Plaintiff's invention in the peculiar action of the rub plates which partially transfer the weight of the load upon the bolster to the suspension springs, and, in so doing, effects a three-point suspension, one around the kingpin and two others, respectively, on each and outside the center of the trailer above the wheels, although the load may not rest on all three points at the same time; thereafter distributing the weight by four-point suspension to the springs and wheels."

And in its Finding of Fact XIX (Tr. Vol. I, p. 63) the District Court finds that Petitioner's trailers embody this invention that was neither claimed nor granted:

> "Said Fruehauf trailers and each of them embody plaintiff's invention as described in Finding of Fact X in that they are so constructed as to distribute the weight from a three-point suspension by a four-point suspension to the springs and wheels with the resulting advantages."

And in its Conclusion of Law VI (Tr. Vol. I, p. 66) the District Court enlarges the scope of the patent to cover an alleged invention never claimed or granted, and holds it to be infringed:

> "The scope of plaintiff's patent extends to and covers in a trailer of the class described the combination of elements claimed therein, which functionally results in a three-point suspension for the bolster and a four-point suspension between the frame and the springs, and each of the trailers described in Finding of Fact XIII manufactured and sold by defendant therefore infringes plaintiff's patent."

The opinion of the District Court (Tr. Vol. I, pp. 35-55) is an argumentative attempt to justify disregard of the explicit claims of the patent, and the reconstruction and enlargement it has been given in the Finding of Fact and Conclusion of Law pointed out above. The District Court has treated the patent as though it disclosed and claimed a trailer frame in which the cross member, forked frame members and rub plates were a single casting. It is obvious from inspection of the patent that it does not teach or describe any such way of making a trailer frame, nor claim a solidly cast structure, nor give any intimation or warning that the patentee regarded and intended to claim any such structure as his invention. The very specification

of the different and various structural parts and elements in the explicit claims conclusively negatives any such intent.

11. Petitioner has contended throughout the case, and in both Courts below, that the patent in suit cannot be enlarged by application of the doctrine of equivalents to include and monopolize a trailer structure neither shown, described, suggested nor claimed in the patent; that it cannot be enlarged by reference to a different and prior trailer structure possessed by respondent, which is neither shown, described nor claimed in the patent, which Respondent knowingly omitted from his application for the patent, and which lacks the element of construction explicitly called for by the claims of the patent; that it cannot be enlarged to recapture scope and breadth of monopoly included in a claim for invention which the Patent Office rejected and with which rejection respondent agreed, and abandoned the claim; and that it cannot be enlarged to monopolize an obvious aggregation of elements conceded to be old in the prior art. The Courts below have persistently and consistently ignored these defenses and the applicable decisions of this Court and have neglected to state any reasons why in their opinion the same are not applicable and controlling.

QUESTIONS PRESENTED

Can patent claims, expressed in plain, unambiguous and explicit language, be enlarged by the Courts by legal construction by application of the doctrine of equivalents to cover and monopolize structures *which are not* described by the claims—

(a) where the structures held to infringe are not shown in the drawings or described in the specification of the patent nor therein suggested as equivalent of the structure explicitly described and claimed,

(b) where the patent contains no warning or evidence of intent to claim and monopolize structures other than or differing from the structures explicitly described in the claims,

(c) where the patentee, prior to applying for the patent, had made and used structures differing from that described and claimed in the patent, in the same respect among others as the structures later accused of infringing the patent differ from that described and claimed in the patent, but which differing structure the patentee knowingly refrained from disclosing in his application for patent,

(d) where the patentee, in the proceedings before the Patent Office on the application for the patent, had presented a claim broader than the claims allowed in the patent, and one that would have covered and monopolized the differing structures he knowingly refrained from disclosing in his application for the patent, and those later accused of infringing the patent, which broader claim was rejected by the

Patent Office and was then voluntarily cancelled out of the application and abandoned by the patentee.

(e) where the trailer structures accused of infringing the patent are not of the construction described and claimed in the patent but are the obvious aggregation of features of construction used for the same purposes and performing no different functions than they served in trailers conceded to be known and in use prior to the patent.

REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT

The Court of Appeals, Ninth Circuit, by affirmance of the judgment of the District Court, has decided questions of the Federal law relating to the application of the doctrine of equivalents in construing patents which are of paramount public importance in a way which conflicts with and is directly contrary to the applicable decisions of this Court.

1. We are aware of the recent decision of this Court in the case of *Graver Tank & Manufacturing Co. Inc. v. Linde Air Products Co.,* decided May 29, 1950, and reported in United States Supreme Court Lawyers' Edition Advance Sheets, Vol. 94, pp. 767-776, 85 U.S.P.Q. 328, espousing broad availability of the doctrine of equivalents in construing patent claims. The difference between the case at bar and that in *Graver Tank & Manufacturing Co. v. Linde Air Products Co., supra,* is that in the Graver case the patent specification itself specifically pointed out as an equivalent the manganese silicate held in the decision to be the equivalent of the alkaline earth metal silicates

specifically mentioned in the claims of the patent. This is not the situation in the case at bar where the structures sought to be held equivalent of that described and claimed in the patent are not disclosed, described nor suggested in the patent, but are subject matter which the patentee knowingly refrained from presenting in his application for patent, and concerning which he voluntarily abandoned in the proceedings in the Patent Office any scope for the patent of its claims which could include the structures accused of infringement.

The case at bar presents vital questions respecting exceptions in the application of the doctrine of equivalents which require immediate clarification by this Court in view of the plain implication of the decision in the Graver case, if previous decisions of this Court respecting the application of the doctrine and the statutory (R. S. 4888, 35 U. S. C. 33) functions of patent claims to define and inform the public of the bounds of patent monopolies are not to be regarded as discarded and in effect overruled.

It is of paramount public importance and essential to the protection of the public interest inherent in all patents that this Court unequivocally establish the principle that the doctrine of equivalents is not available to warrant disregard of plain, unambiguous and explicit terms of patent claims in the absence of clear and express warning in the patent of intent to include in the scope of the claims undisclosed subject matter differing from that expressly described and explicitly claimed, and that all reasonable doubts of such intent shall be resolved against the patentee and in favor of the public.

To do less, and to permit the patentees who explicitly define the monopolies they seek in order to obtain them to

afterward repudiate those explicit definitions and claim subject matter never described or suggested in the patent nor submitted to scrutiny of the Patent Office as has been done in this case, is to make patents into instruments for perpetrating fraud on the public and to invite that use of them.

2. The Court below has sustained the application of the doctrine of equivalents to effect an enlargement of scope of an original patent which could not be validly or lawfully obtained under the statute governing reissue of patents (R. S. Sec. 4916, 35 U. S. C. 64). This is a new question respecting the application of the doctrine of equivalents, and is an important question of Federal law which has not been, but should be, settled by this Court.

This Court has established it to be the law that if the patentee was the author of any other invention than that which he specifically describes and claims, and which he migh have asked to have patented at the same time in the same patent but has not done so, that he cannot expand and generalize the claims by reissue of his patent to secure it. Also, that if there be failure of disclosure in the original patent of matter claimed in the reissue, it will not aid the patentee that the new matter covered by the reissue was within his knowledge when he applied for his original patent, that it is not enough that an invention might have been claimed in the original patent, and that it must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original. *James v. Campbell,* 104 U. S. 356-385; 26 L. Ed. 786, 791; *U. S. Industrial Chemicals Inc. v. Carbide & Carbon Chemicals Corp.,* 315 U. S. 668, 676; 86 L. Ed. 1105, 1112. In the case at bar, Respondent, knowingly, as in the cases above cited, omitted from his ap-

plication for patent the trailer structure which he then possessed and which did not contain or employ the element of the outside leg of the forked frame member extending above the cross member to form rub plates. He now seeks to enlarge his patent to cover and monopolize this omitted structure. The Courts below have acceded. Under the decisions above cited he is prohibited to obtain a valid reissue of his patent to include this omitted subject matter. Certainly the courts cannot do this by resort to the doctrine of equivalents as the Courts below have done in this case. To fail to overturn such a decision is to sanction complete nullification and illegal circumvention of the reissue statute by resort to the doctrine of equivalents.

This Court has held that if an alteration of one of the essential elements of a claimed combination were permissible at all, it would be under the reissue statute (R. S. 4916, 35 U. S. C. 64) which grants rights only from the date of reissue and after consideration by the Patent Office. *Milcor Steel Co. v. George A. Fuller Co.*, 316 U. S. 143, 148; 86 L. Ed. 1332, 1335. Certainly an enlargement of a claimed combination by omission of an element explicitly specified therein cannot be had by resort to the doctrine of equivalents.

3. The Courts below have sanctioned resort to the doctrine of equivalents to recapture scope and breadth for a patent which was rejected by the Patent Office and voluntarily abondoned by the applicant. As pointed out in the summary statement, the Patent Office rejected and Respondent voluntarily cancelled and abandoned the only claim which applicant ever presented to the Patent Office which did not include the element—the outer side of the forked frame member extending above the cross member to form rub plates. All remaining claims in the application, which are those that were granted in the patent, explicitly

call for the element in question, and its presence was relied upon by Respondent to obtain allowance of the patent. But the Courts below apply the doctrine of equivalents to recapture and subject to the monopoly of the patent structures which omit the element and which were never within the scope of any claim presented in the application except the claim that was cancelled and abandoned. This is directly contrary to the applicable decision of this Court in *Exhibit Supply Co. v. Ace Patents Corp.,* 315 U. S. 126, 136-137; 86 L. Ed. 736, 744-745, and the authorities there cited, where it is held that whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment, and that the doctrine of equivalents at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed.

It is also in conflict with the decision of this Court in *Sontag Chain Stores Co. Ltd. v. National Nut Company of California,* 310 U. S. 281, 293; 84 L. Ed. 1204, 1211-1212, where it is held to be the law that a patentee's claim of a specific device or combination, and omission to claim other devices or combinations apparent on the face of the patent, are in law a dedication to the public of that which is not claimed.

4. The Courts below have sanctioned the practice, condemned by this Court, of disregarding the separate and distinct claims of the patent, and have used the doctrine of equivalents to make and uphold a patent which was neither claimed nor granted. This is contrary to the decision in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.,* 294 U. S. 477, 487; 79 L. Ed. 1005, 1012, where

it is held that the Courts have no right to disregard the separate claims of a patent and reconstruct it to make it a patent which was neither claimed nor granted. It is in conflict with the decision in *White et al v. Dunbar,* 119 U. S. 47; 30 L. Ed. 303, 304, 305, where it is held that the claim of a patent is a statutory requirement prescribed for the very purpose of making a patentee define precisely what his invention is, and that it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. Also with the decision in *Keystone Bridge v. Phoenix Iron Co.,* 95 U. S. 274, 278; 24 L. Ed. 344, 346, where it is held that Courts cannot alter or enlarge a specific claim; that they have no right to enlarge a patent beyond the scope of its claim, that patentees are bound by their claims and cannot show that their patent is broader than the terms of their claim. Also with the decision in *McClain v. Ortmayer,* 141 U. S. 419-429; 35 L. Ed. 800, 802, where it is held that the claim is the measure of the patentee's right to relief, and that while the specification of a patent may be referred to limit the claim, it can never be made available to expand it even though the patentee might have been entitled to a broader claim.

It has been reiterated by this Court that the claim of a patent is the measure of the grant, and is required to be specific in order to protect the public against extension of the scope of the patent. *Universal Oil Products Co. v. Globe Oil & Refining Co.,* 322 U. S. 471, 484-485; 88 L. Ed. 1399-1407.

5. The Courts below have applied the doctrine of equivalents to enlarge the scope of the explicit terms of the claims of the patent to include and monopolize the obvious

aggregations of elements common in the prior art which Petitioner has the right to use.

As pointed out in the Summary Statement, it is uncontroverted that Petitioner's cross member with rub plates and swinging bunk is the same in arrangement and function as that shown in the prior Merrill patent Exhibit R-20; and that Petitioner's forked frame members are arranged and function the same as they do in the prior art solely to connect the underside of the main frame member of the trailer to the springs. The decision of the Courts below subjecting these obvious aggregations of the structural elements common in the prior art to the monopoly of Respondent's patent by resort to the doctrine of equivalents is in clear conflict with the decision of this Court in *Hailes v. Van Wormer*, 87 U. S. 353; 22 L. Ed. 241, 248, where it is held that merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel is not invention; and that combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Also with the decision in *Grinnell Washing Machine Co. v. E. E. Johnson Co.*, 247 U. S. 426, 432-434; 62 L. Ed. 1196, 1199-1200, where it is held that the production of a more convenient and economical mechanism than others and superiority thereof does not make an aggregation patentable. Also with the decisions in *Powers Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U. S. 175, 186; 75 L. Ed. 278, 286; and *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, 486; 79 L. Ed. 1005, 1011-1012; where it is held that the bringing together of old elements, in a mechanism involving no new principles, to produce an old result, is not invention even though the machine produced is one of greater precision and hence more useful in the art.

6. The Court of Appeals, Ninth Circuit, has so far departed from the accepted and usual course of judicial proceedings, and has so far sanctioned such a departure by the District Court, as to call for the exercise of this Court's power of supervision.

Petitioner has persistently and consistently brought to the attention of and urged upon the Courts below the law established by the decisions of this Court and the application thereof to the controlling and uncontroverted facts in this case. The Courts below have as persistently and consistently ignored this law, and have neglected to state any reasons why in their opinion it is not applicable.

Petitioner has conducted its defense in this case in good faith and in the firm belief that under the established law it is not guilty of infringing the patent in suit for the reasons given, and has been put to a very considerable expense. It submits that the defenses which it has advanced are substantial, worthy of full consideration and treatment, and entitled to prevail; and that the summary treatment of its defenses that has been accorded to it by the Courts below is manifestly unjust and such a departure from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision.

Wherefore, Petitioner prays that a writ of certiorari issue under the seal of this Court directed to the United States Court of Appeals for the Ninth Circuit sitting at San Francisco, California, commanding said Court to certify and send to this Court on a day to be designated a full and complete transcript of the record and all proceedings of the said Court of Appeals had in the case numbered and entitled on its docket 12,253, *Fruehauf Trailer Company of California,* doing business in Oregon as Fruehauf Trailer & Equipment Company, Appellant, *v. Henry Clay Myers,* Appellee, to the end that this cause may be reviewed and

determined by this Court; that the judgment therein of said Court of Appeals be reversed by this Court; and that Petitioner have such other and further relief as this Court may deem proper.

ARTHUR W. DICKEY,
Counsel for Petitioner.

HARNESS, DICKEY & PIERCE,
7—141 General Motors Building,
Detroit 2, Michigan,

PENDERGRASS, SPACKMAN & BULLIVANT,
527 Pacific Building,
Portland 4, Oregon,

DAVIES, RICHBERG, BEEBE,
LANDA & RICHARDSON,
1000 Vermont Avenue, N. W.,
Washington 5, D. C.,
Of Counsel.

BRIEF IN SUPPORT OF PETITION

JURISDICTION

The jurisdiction of this Court is invoked and sustained under U. S. Code, Title 28, Sec. 1254 (1), and Sec. 2101 (c).

This Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit is presented within 90 days after the Order of said Court of Appeals entered on May 10, 1950, denying Petitioner's Petition for Rehearing filed April 22, 1950, within 30 days after Entry of Judgment of said Circuit Court of Appeals on March 24, 1950.

April 13, 1949, Judgment of United States District Court for District of Oregon entered (Tr. Vol. I, pp. 68-70)

April 30, 1949, Petitioner's Notice of Appeal to United States Court of Appeals, Ninth Circuit, filed (Tr. Vol. I, pp. 70-71)

March 24, 1950, Judgment of United States Court of Appeals for Ninth Circuit affirming Judgment of District Court entered (Tr. Vol. IV, p. 1417)

April 22, 1950, Appellant's Petition for Rehearing filed (Tr. Vol. IV, p. 1418)

May 10, 1950, Order denying Appellant's Petition for Rehearing entered (Tr. Vol. IV, p. 1418).

DECISIONS WHICH SUSTAIN THE JURISDICTION OF THIS COURT AND SUPPORT REASONS FOR GRANTING THIS PETITION

Halliburton Oil Wells Cementing Co. v. Walker et al., 329 U. S. 1, 2, 3; 91 L. Ed. 3, 6;

Graver Tank & Manufacturing Company v. Linde Air Products Company, 336 U. S. 271, 272, 273; 93 L. Ed. 672, 675;

Faulkner v. Gibbs, decided November 7, 1949 Lawyers' Edition Advance Opinions, U. S. Supreme Court, Vol. 94, No. 1, p. 30;

where there was no conflict of decision in the several Circuit Courts of Appeal but where this Court was moved to grant the Petitions by the importance and nature of the questions presented. It is urged that the questions presented in the instant case are of equal public importance and that their consideration and decision by this Court is urgently needed to remove uncertainties in the application of the doctrine of equivalents.

Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47, 50;

Muncie Gear Works v. Outboard Co., 315 U. S. 759, 768;

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126, 128;

where this Court acted to grant the Petition although there was no conflict of decision in the several Circuit Courts of Appeal, and were moved to grant the Petition by the nature of the questions presented and a showing that the industry affected by the patent was chiefly located in a single circuit so that litigation in other circuits resulting in conflict of decision would not be likely to occur. In the

present case, it is shown by the affidavit of F. V. Bistrom included in the Appendix hereto that the manufacture, sale and use of dual axle logging trailers which are the subject of the patent in suit, is substantially confined within the States comprising the Ninth Judicial Circuit.

Respondent and patentee resides in Oregon within the Ninth Judicial Circuit, has repeatedly instituted suit for infringement of the patent in that circuit, and in no other circuit.

It is therefore unlikely that the patent will ever be litigated in another circuit where conflict of decision might arise.

Previous litigation for infringement of the patent, to which Petitioner was not a party, has occurred in the Ninth Circuit and is reported in *Myers v. Beall Pipe & Tank Corp.*, 36 F. Supp. 752, and in *Page et al. v. Myers*, 155 F. (2) 57. Both of these decisions disregard and ignore the plain and explicit claims of the patent, reconstruct and enlarge the monopoly of the patent, and take no consideration of the law and the applicable decisions of this Court which have been urged in the case at bar.

SPECIFICATION OF ERRORS

The United States Court of Appeals for the Ninth Circuit erred:

1. In affirming the enlargement of the scope of the patent in suit by the District Court to find infringement by Petitioner.
2. In affirming the application of the doctrine of equivalents by the District Court to find infringement by Petitioner.

3. In failing to hold Respondent estopped to enlarge the scope of the patent in suit beyond its plain, unambiguous and explicit disclosure and terms to find infringement by Petitioner.

4. In failure to hold Respondent estopped to resort to the doctrine of equivalents to find infringement by Petitioner.

5. In affirming the Judgment of the District Court adjudging infringement of the patent in suit by Petitioner.

6. In failing to reverse the Judgment of the District Court adjudging infringement of the patent in suit by Petitioner.

STATEMENT OF THE CASE

The material facts are stated in the Summary Statement of Matter Involved with the exception of the following additional matters which should be noted.

The Myers Patent in Suit Has Had No Material Commercial Success

Respondent concedes (Tr. Vol. II, pp. 921-922) that only nine trailers of the design and construction shown in the patent have ever been made, seven of which were built by Beall Pipe & Tank Corp. These are referred to in the decision of the District Court in the case of *Myers v. Beall Pipe & Tank Corp.*, 36 F. Supp. 752, at p. 753:

> "Defendant did construct a trailer according to the design of Myers. There was a test conducted.

> * * * Apparently the conditions precedent were fulfilled, because Defendant constructed six more trailers of this type. Defendant then began to receive complaints that the construction was too light and flimsy on account of the absence of a cross shaft, among other things. Defendant took back one trailer and made repairs upon others. * * *
>
> "In view of complaints above mentioned, defendant abandoned the construction of Myers' type of trailer and began to build 'Model 906'. This device was much heavier in construction and had a cross shaft."

The two additional trailers built according to the design of the patent were ones built by Hughes and Stein and which Myers engineered and supervised (Tr. Vol. II, p. 762). These are the ones illustrated in photographs Exhibits R-6 and R-7 (Tr. Vol. III, p. 1099) and reproduced in drawings in the appendix hereto, along with pertinent figures of the Myers patent drawing, for convenient reference.

Exhibits R-6 and R-7 demonstrate that these trailers were of the same design and construction shown and claimed in the Myers patent in suit, and that they are substantially different from Petitioner's structures.

There is no evidence that any other trailers of the construction shown and claimed in the patent have been made by Respondent or his licensees.

Respondent Myers Was Not the Sole Author of Dual Axle Logging Trailers Employing Forked or Straddle Type Spring Mountings for Main Frames With Rub Plates and Swinging Bunks

According to Myers (Tr. Vol. II, pp. 746, 747), the State gave permission to use dual axle logging trailers on the

public highways in or about 1935. When that occurred, not only Myers, but others (Clark, Shuey and Reliance—evidence designated below) began at about the same time to construct dual axle trailers in blacksmith shops and garages. They all promptly used this forked or straddle type mounting, just as the conventional freight trailers had been doing for years, to mount the cross members or main frames on the trunnions carried by the springs. Some of them, Myers in his 1935 construction, Clark and Reliance, mounted the old separate rub plates on the cross members and main frames which is the practice Fruehauf has followed, and Shuey put his rub plates on the under side of the swinging bunk. None of them made the rub plate a part of the outside leg of the forked frame, none of them extended the outside leg of the forked frame to engage the swinging bunk directly and independently of the cross members or main frame according to the Myers patent. That idea did not appear until after the Myers sketch, March 20, 1937 (Exhibit 147, Tr. Vol. III, pp. 1373-75), which is the conception of the Myers patent.

Clark prior use trailers of 1934-1935.

Clark United States Patent No. 2,094,836—Application filed December 14, 1935.

(Exhibits, photographs R-36 to R-39; Tr. Vol. III, pp. 1215-1221; Exhibit R-41; patent; Tr. Vol. III, pp. 1225-1233; testimony, Tr. Vol. I, pp. 108-316).

Shuey prior use trailer, 1935

(Exhibits 124-A to 124-D; Tr. Vol. III, pp. 1341-1347; testimony, Tr. Vol. I, pp. 423-504, Vol. II, pp. 505-527).

Reliance Trailer Model 418L and 424L, 1936, and January, 1937

(Reliance depositions Exhibit 7, *Supplemental* Book of Exhibits, p. 1393; testimony; i.e. Exhibit 7, Model 418L and 424L, Tr. Vol. III—Tice pp. 1190-1192, Konetsky pp. 1201-1202).

As Myers is not entitled to any date earlier than March 20, 1937, for the invention described and claimed in his patent in suit (Tr. Vol. II, pp. 913-914), the Clark, Shuey and Reliance trailers, as well as the other and prior instances of straddle type mountings cited, are clearly within the art available prior to the Myers patent.

The applicable decisions of this Court and the conflicts therewith that are complained of are sufficiently cited in the Reasons Relied Upon for Allowance of the Writ. It is respectfully submitted that Petition should be granted and the Writ issued.

ARTHUR W. DICKEY,
Counsel for Petitioner.

HARNESS, DICKEY & PIERCE,
7—141 General Motors Building,
Detroit 2, Michigan,

PENDERGRASS, SPACKMAN & BULLIVANT,
527 Pacific Building,
Portland 4, Oregon,

DAVIES, RICHBERG, BEEBE, LANDA & RICHARDSON,
1000 Vermont Avenue, N. W.,
Washington 5, D. C.,
Of Counsel.

APPENDIX

Affidavit of F. Vernon Bistrom

State of Washington,
County of King—ss.

F. Vernon Bistrom, being duly sworn, deposes and says that he is forty-three (43) years of age, that he resides in the City of Seattle, State of Washington, that he is a graduate and licensed mechanical engineer, that since 1938 he has been continuously employed by the Fruehauf Trailer Company, a Michigan corporation, and its subsidiary corporation, the Fruehauf Trailer Company of California, the defendant in the suit in the United States District Court of Oregon entitled Henry Clay Myers v. Fruehauf Trailer Co. of California, Civil Action No. 3115, for infringement of United States Letters Patent No. 2090874, relating to dual axle logging trailers. That he is familiar with the dual axle logging trailers described in said patent and with the dual axle logging trailers accused in said suit of infringing said patent, that the business of the Fruehauf Trailer Company, a Michigan corporation, and its subsidiary, said Fruehauf Trailer Company, has been and is the manufacturing and sale of automotive trailer equipment and it sells such equipment throughout the United States of America. That during the course of his said employment he has had charge of the design, engineering and construction of the dual axle logging trailers made and sold by his said employers. That deponent has made and now makes it his business as a part of his said employment to maintain familiarity with the commercial production and sale of dual axle logging trailers and the market therefor. That during his said employment substantially the entire market for dual axle logging trailers and the use thereof has

been and now is within the States of Washington, Oregon, California, Montana, Idaho, Nevada, and Arizona, where the largest timber and heaviest logging operations in the United States are chiefly concentrated and that there is no substantial demand or market for dual axle logging trailers in other parts of the United States, in which lighter single axle trailers are chiefly used. That substantially all of the manufacturing of dual axle logging trailers in the United States is carried on in the States of California, Oregon and Washington.

Signature: F. Vernon Bistrom.

Subscribed and sworn to before me this 14th day of July, 1950.

R. L. Salmon,
Notary Public in and for the State of Washington, residing at Seattle.
My commission expires July 18, 1952.

(Notarial Seal.)

35 U. S. C. Sec. 33; R. S. 4888—Application for Patent; Description; Specification and Claim

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it

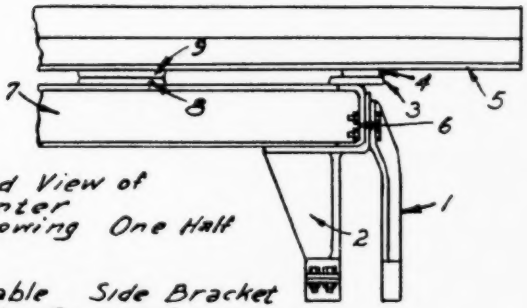
from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible. (R. S. Sec. 4888; Mar. 3, 1915, ch. 94, sec. 1, 38 Stat. 958; May 23, 1930, ch. 312, sec. 2, 46 Stat. 376.)

35 U. S. C. Sec. 64; R. S. 4916—Reissue of Defective Patents

Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each

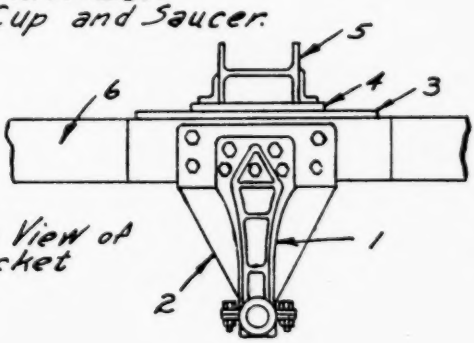
of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. (R. S. sec. 4916; May 24, 1928, ch. 730, 45 Stat. 732.)

PLAINTIFF'S EX. - R-11



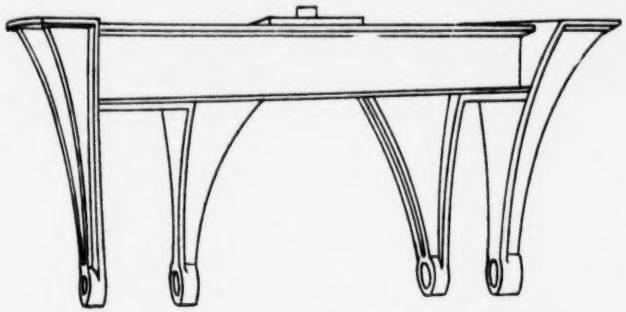
End View of Center Showing One Half

1. Removable Side Bracket Outside Support.
2. Inside Support Bracket.
3. Rub Plate On Trailer Frame.
4. Rub Plate On Bunk.
5. Bunk.
6. Frame.
7. Cross Member.
8. and 9. Cup and Saucer.



Side View of Bracket

MYERS PATENT 2090874



PLAINTIFF'S EXHIBIT NO. R-6

PLAINTIFF'S EXHIBIT NO. R-7

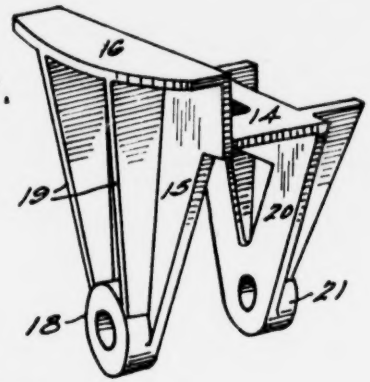
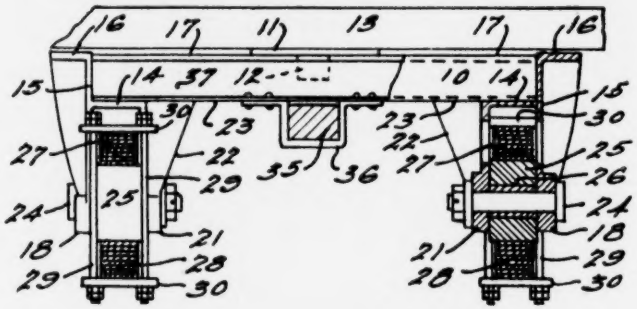


Fig. 1.

Fig. 3.



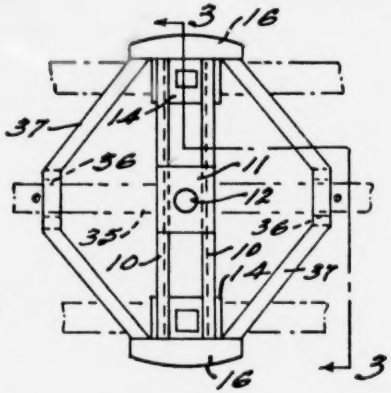
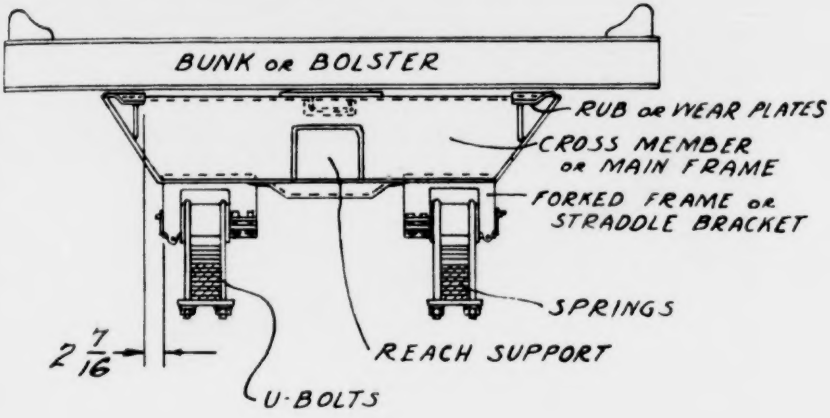
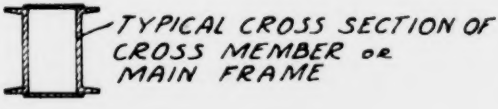
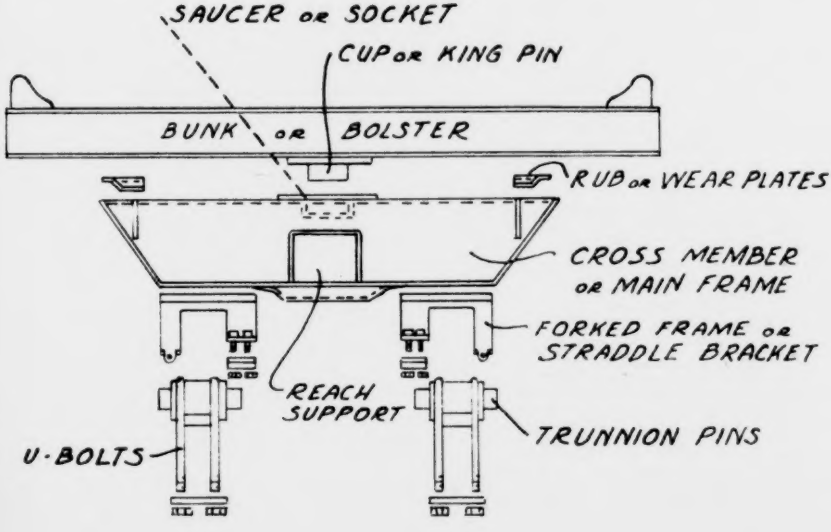


Fig. 2.

EX. PRINTS - 122 - B1 TO 4
EX. PHOTOS - 117 - 118

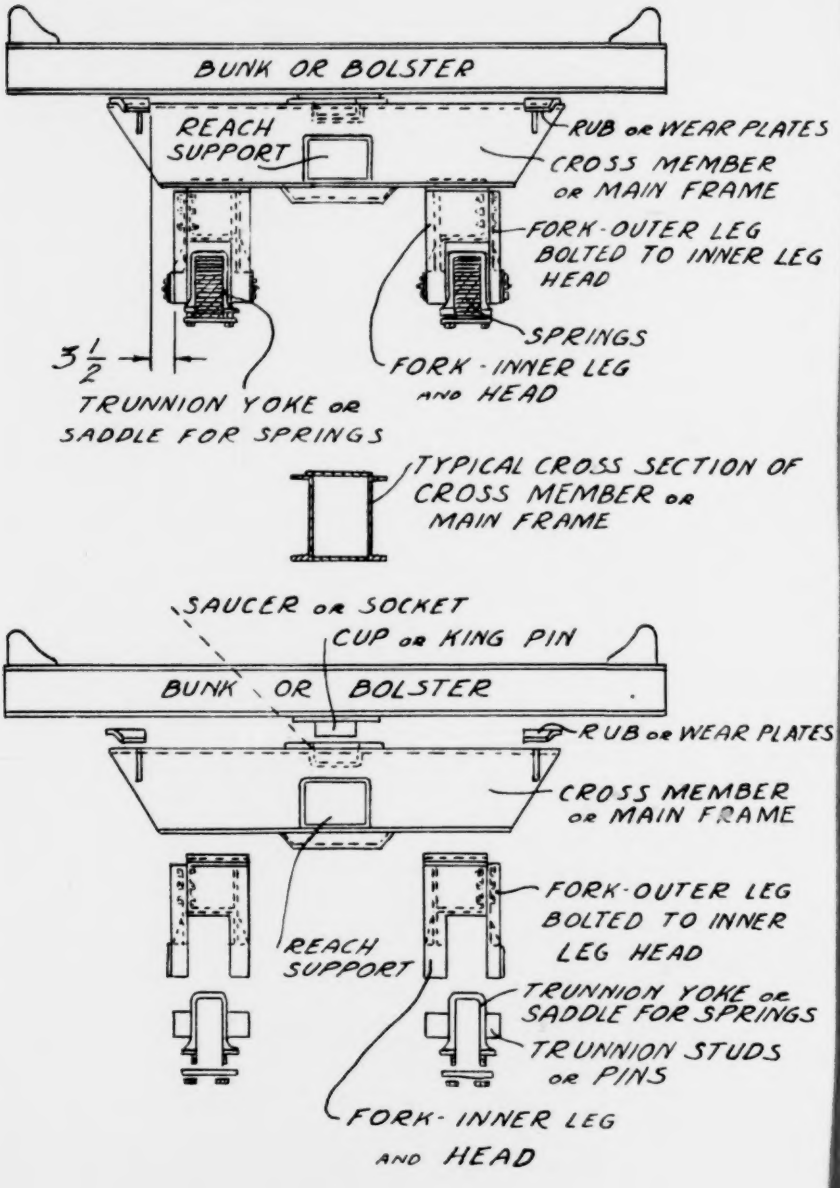






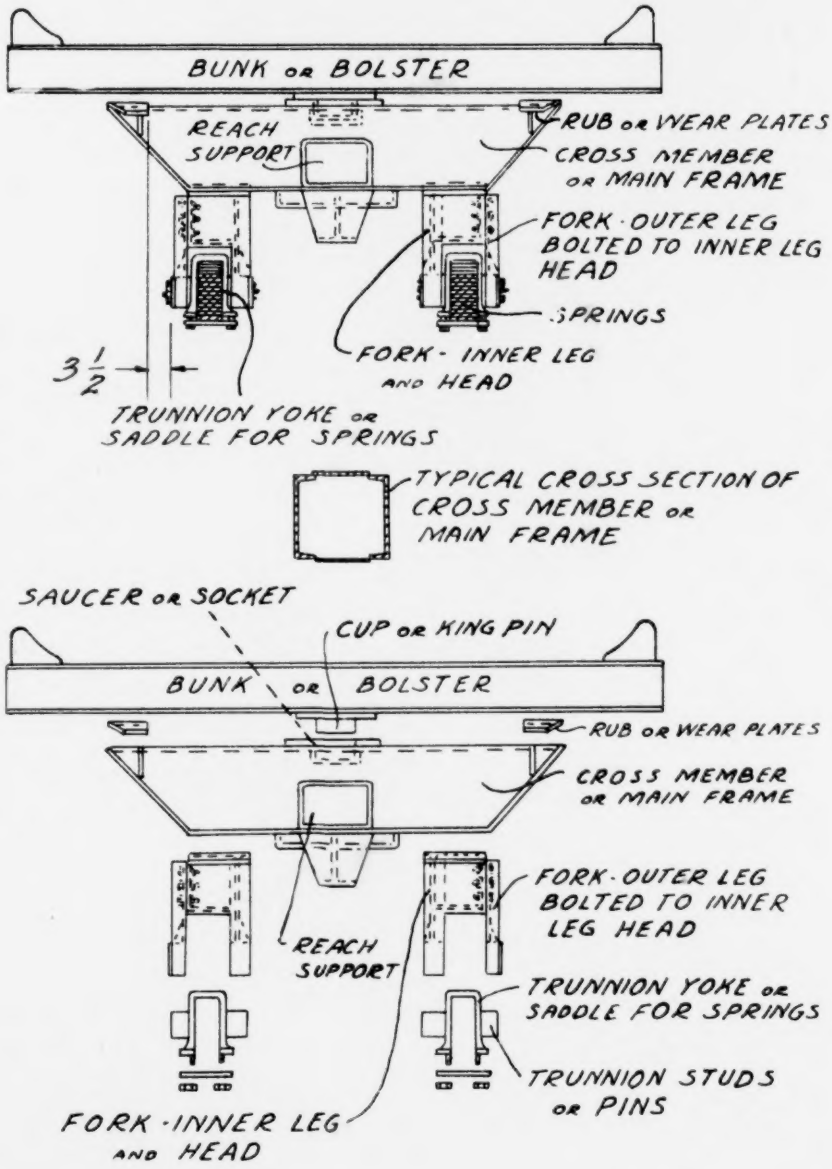
Fruehauf - First Const.

EX PRINTS - 122 - B-5 TO 9
EX PHOTOS - 119 - 120 - 121



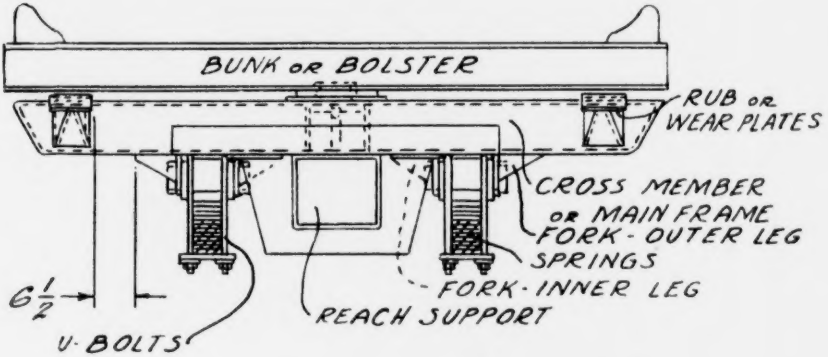
Fruehauf - Second Const.

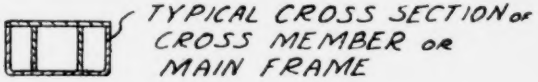
EX. PRINTS - 122 - B-5 TO 9
EX. PHOTOS - 122 - B-13 & 14

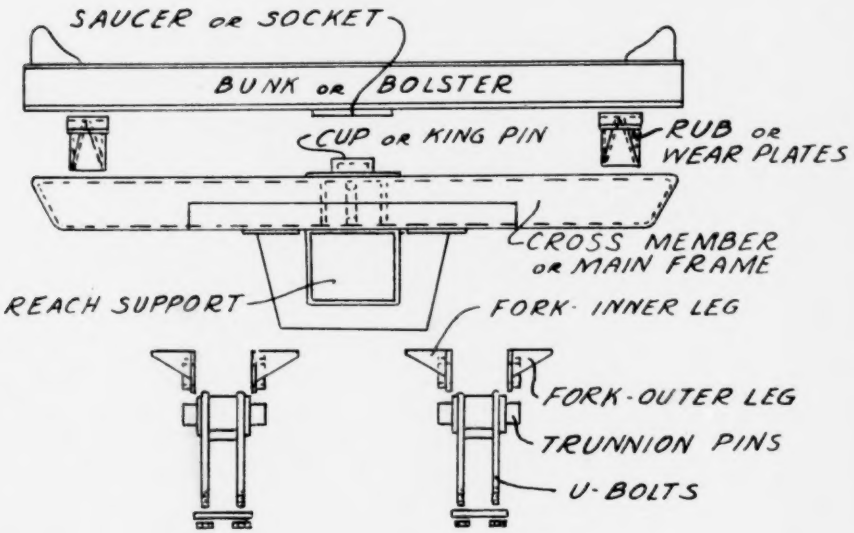


Fruehauf - Third Const.

EX PRINTS - 122 - B-10
EX PHOTOS - 122 - 122a

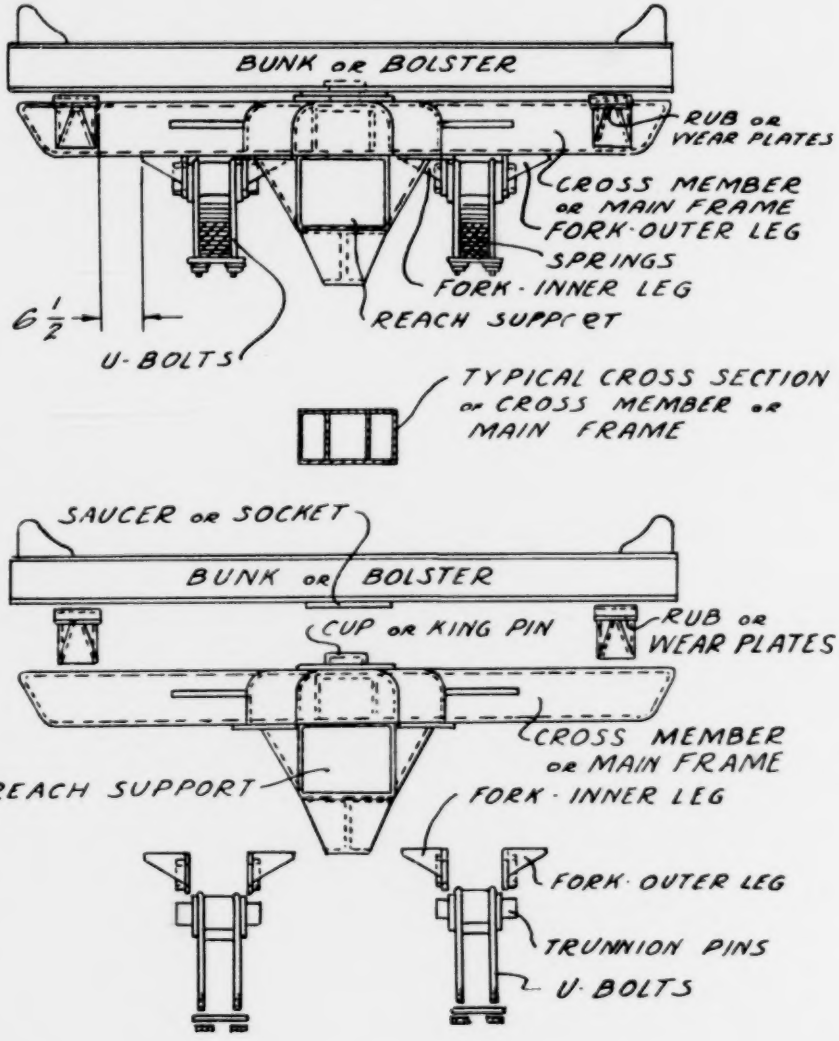






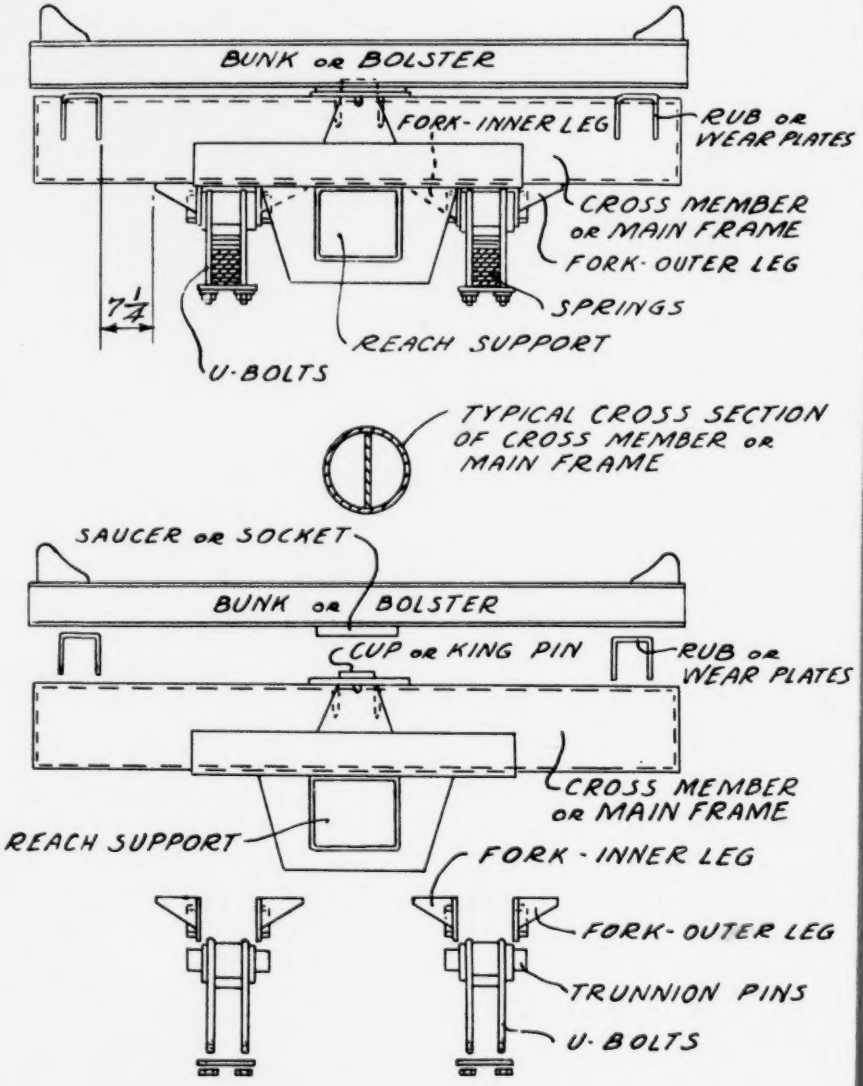
Fruehauf - Fourth Const.

EX PRINTS - 122 - B-11
EX PHOTOS - 122 - 122a



Fruehauf - Fifth Const.

EX PRINTS - 122 - B-12



Fruehauf - Sixth Const.